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10/17/02

**AMENDMENT AND RESPONSE TO
OFFICE ACTION DATED JULY 18, 2001**

The present paper is submitted as a complete response to the Office Action mailed April 10, 2002 and, in this regard, Applicants respectfully request consideration of the amendments and remarks herein below. No additional fees are believed due with the submission of this Amendment and Response to Office Action; however, should any additional fees be required, or if either or both of the aforementioned checks are missing, the Commissioner is authorized to deduct said fees from Akin, Gump, Strauss, Hauer & Feld, L.L.P. Deposit Account No. 01-0660/043829.0048.

AMENDMENT

In The Claims

Please cancel Claims 75-97 without prejudice.

Please amend Claims 1, 68 and 70; a clean copy of these amended claims is included in Attachment A hereto, and a marked-up version of the amended claims is included in Attachment B hereto.

RESPONSE TO OFFICE ACTION

I. Restriction Requirement

In regard to claims 75-97, and to the extent required, Applicants affirm the provisional election made by Applicants to the Examiner on April 2, 2000, and in response to the Restriction Requirement, Applicants confirm the election, without traverse, of the invention of Species III and sub-Species III, comprising claims 74, 53, 64 and 65 (previously elected) as well as claims 75, 83, 94, and 95. Applicants reserve the right to file a divisional application on the nonelected

invention. However, the foregoing notwithstanding, Claims 75-97 have been cancelled and the Applicants respectfully submit that the restriction requirement as to Claims 75-97 is now moot.

II. Status of the Claims/Amendments

Claims 75-97 are cancelled. Claims 1, 3-68, 70, and 72-74 are pending. Claims 5-45 and 72-73, are non-elected.

III. The Drawings

In the Office Action, the Examiner approved the corrected informal drawings as submitted with the previous office action but noted that the drawings were not approved by the draftsman. In response, Applicants acknowledge their obligation to submit formal drawings, acceptable to the draftsman, immediately upon allowance of any claims and prior to issuance of any resultant letters patent.

IV. Priority

In the Office Action, the Examiner noted that this application repeats a substantial portion of prior Application No. 09/224,148, filed December 31, 1998, adds and claims additional disclosure not presented in the prior application, and may constitute a continuation-in-part of the prior application. The Examiner further suggests that, should Applicants desire to obtain the benefit of the filing date of the prior application, Applicants attention is directed to 35 U.S.C. 120 and 37 C.F.R. 1.78.

In response, Applicants respectfully submit and confirm that the present application is indeed a continuation-in-part of the prior application as denoted and enabled by the first lines of the amended specification submitted in the response to the previous Office Action in this matter and which, given the filing date of the present application, Applicants believe to be in conformance with the provisions of 35 U.S.C. 120 and 37 C.F.R. 1.78. However, if such is not

the case, or if the language of the amended specification is for any reason deemed inadequate to confer upon the present application the benefit of the filing date of the prior application, Applicants respectfully request further guidance regarding this matter.

V. Rejection of Claims 1, 4, 74, 75, and 70 for Double Patenting

Claims 1, 4, 74, 75, and 70 were rejected by the Examiner under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 13, and 21 of U.S. Patent No. 6,351,764 (the “’764 Patent”).

In response, Applicants respectfully submit that Claims 1, 4, 74, 75, and 70 were also rejected by the Examiner on other grounds and, thus, these claims may require further revisions to the claim language prior to allowance. Since any such further revisions may work to effectively distinguish these claims from the corresponding claims of the ‘764 Patent, Applicants respectfully request that this rejection be held in abeyance until such time these claims are otherwise allowable except to the extent of any double-patenting objection.

VI. Rejection of Claims 1, 3, 68, and 70 under 35 U.S.C. § 102(b)

Claims 1, 3, 68, and 70 were rejected under 35 U.S.C. § 102(b) as being anticipated by Scannell et al. (U.S. Patent No. 5,577,354). In response Applicants have amended Claims 1, 68, and 70 to include the additional element of depositing the message into at least one of a plurality of virtual mailboxes wherein the message is sorted within such virtual mailbox(es) based on the priority code such virtual mailbox(es) based on the priority code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.” Moreover Claim 3, which depends on Claim 1, likewise includes this additional element.

Scannell nowhere discloses sorting and depositing the e-mail message into a plurality of virtual mailboxes wherein at least two of such virtual mailboxes are capable of sorting. Scannell instead teaches the use of one main “in tray” (col. 8, lines 14-15) that alone possesses sorting capabilities. For this reason, Applicants respectfully request that this rejection under § 102(b) be withdrawn.

VII. Rejection of Claim 75 under 35 U.S.C. § 102(e)

Claim 75 was rejected under 35 U.S.C. § 102(e) as being anticipated by Rochkind (European Patent No. 0825752 A2). In response, Applicants have cancelled Claim 75 and respectfully submit that the rejection as to Claim 75 is now moot.

VIII. Rejection of Claim 74 under 35 U.S.C. § 103(a)

Claim 74 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Rochkind (European Patent No. 0825752 A2). However, in view of the amendments made herein to Claim 1, from which Claim 74 depends, Applicants respectfully submit that Claim 74 is also not anticipated by the combination of Scannell and Rochkind due to the additional element of sorting and depositing the voicemail message into a plurality of virtual mailboxes wherein the voicemail message is sorted within such virtual mailboxes based on the assigned code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.”

In order to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claim

elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and cannot be based on applicant's disclosure. (MPEP §§ 2142, 2143.)

In regard to Claim 74, Applicants have amended Claim 1, upon which Claim 74 depends, to include the additional element of depositing the message into at least one of a plurality of virtual mailboxes wherein the message is sorted within such virtual mailbox(es) based on the priority code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.” Neither Scannell nor Rochkind disclose inventions with no less than two such virtual mailboxes from among the plurality of virtual mailboxes that are capable of sorting. Therefore, neither Scannell nor Rochkind, separately or in combination, teach or suggest all the claim elements of the present invention, and Applicants respectfully submit that a finding of obviousness in regard to amended Claim 74 is unsupported by these references.

IX. Rejection of Claims 4 and 66 under 35 U.S.C. § 103(a)

Claims 4 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Lim (U.S. Patent No. 5,883,942). However, in view of the amendments made herein to Claim 1, from which both Claims 4 and 66 depend, Applicants respectfully submit that Claims 4 and 66 are not anticipated by the combination of Scannell and Lim due to the additional element of sorting and depositing the voicemail message into a plurality of virtual mailboxes wherein the voicemail message is sorted within such virtual mailboxes based on the assigned code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.”

As previously mentioned, in order to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and cannot be based on applicant's disclosure. (MPEP §§ 2142, 2143.)

In regard to both Claims 4 and 66, Applicants have amended Claim 1, upon which both Claims 4 and 66 depend, to include the additional element of depositing the message into at least one of a plurality of virtual mailboxes wherein the message is sorted within such virtual mailbox(es) based on the priority code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.” Neither Scannell nor Lim disclose invention wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting. Therefore, neither Scannell nor Lim, separately or in combination, teach or suggest all the claim elements of the present invention, and Applicants respectfully submit that a finding of obviousness in regard to amended Claims 4 and 66 are unsupported by these references.

X. Rejection of Claim 67 under 35 U.S.C. § 103(a)

Claims 67 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Katz (U.S. Patent No. 5,646,839). However, in view of the amendments made herein to Claim 1, from which Claims 67 depends, Applicants respectfully submit that Claim 67 is also not anticipated by the combination of Scannell and Katz due to the additional element of sorting and

depositing the voicemail message into a plurality of virtual mailboxes wherein the voicemail message is sorted within such virtual mailboxes based on the assigned code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.”

As previously mentioned, in order to establish a prima facie case of obviousness, the third criteria is that the prior art reference (or references when combined) must teach or suggest all the claim elements. In regard to Claims 67, Applicants have amended Claim 1, upon which Claim 67 depends, to include the additional element of depositing the message into at least one of a plurality of virtual mailboxes wherein the message is sorted within such virtual mailbox(es) based on the priority code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.” Neither Scannell nor Katz disclose inventions wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting. Therefore, Applicants respectfully submit neither Scannell nor Katz, separately or in combination, teach or suggest all the claim elements of the present invention, and Applicants further submit that a finding of obviousness in regard to amended Claim 67 is unsupported by these references.

XI. Rejection of Claims 64-65 under 35 U.S.C. § 103(a)

Claims 64-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Rochkind and Lim. However Applicants respectfully submit that, in view of the amendments made herein to Claim 1 from which Claims 64-65 depend, Applicants respectfully submit that Claims 64-65 are not anticipated by the combination of Scannell, Rochkind and Lim due to the additional element of sorting and depositing the voicemail message into a plurality of virtual mailboxes wherein the voicemail message is sorted within such virtual mailboxes based

on the assigned code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.”

As discussed earlier herein, neither Scannell, Rochkind, nor Lim disclose inventions wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting. Therefore Scannell, Rochkind, and Lim, separately and in combination, fail to teach or suggest all the claim elements of the present invention, and Applicants respectfully submit that a finding of obviousness in regard to Claims 64-65 is unsupported by these references.

XII. Rejection of Claims 53 under 35 U.S.C. § 103(a)

Claim 53 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Rochkind and Katz. However Applicants respectfully submit that, in view of the amendments made herein to Claim 1 from which Claim 53 depends, Applicants respectfully submit that Claim 53 is also not anticipated by the combination of Scannell, Rochkind and Katz due to the additional element of sorting and depositing the voicemail message into a plurality of virtual mailboxes wherein the voicemail message is sorted within such virtual mailboxes based on the assigned code and “wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting.”

As discussed earlier herein, neither Scannell, Rochkind, nor Katz disclose inventions wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting. Therefore Scannell, Rochkind, and Katz, separately and in combination, fail to teach or suggest all the claim elements of the present invention, and Applicants respectfully submit that a finding of obviousness in regard to Claim 53 is unsupported by these references.

XIII. Rejection of Claims 83 under 35 U.S.C. § 103(a)

Claim 83 was rejected under 35. U.S.C. § 102(e) as being unpatentable over Rochkind in view of Katz. In response, Applicants have cancelled Claim 83 and respectfully submit that the rejection as to Claim 83 is now moot.

XIV. Rejection of Claims 94 and 95 under 35 U.S.C. § 103(a)

Claims 94 and 95 were rejected under 35. U.S.C. § 102(e) as being unpatentable over Rochkind in view of Lim. In response, Applicants have cancelled Claims 94 and 95 and respectfully submit that the rejections as to Claims 94 and 95 are now moot.

XV. Rejection of Claims 1 and 74 under 35 U.S.C. § 103(a)

Claims 1 and 74 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Using Outlook's Rules Wizards and Assistants (January 1998) (hereinafter "Outlook 98") in view of CallegraDesk™ for Microsoft Outlook/Exchange (August 1998) (hereinafter ("CallegraDesk").

In response Applicants have amended Claims 1 to include the additional element of depositing the message into at least one of a plurality of virtual mailboxes wherein the message is sorted within such virtual mailbox(es) based on the priority code such virtual mailbox(es) based on the priority code and "wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such sorting." Moreover, Claim 74, which depends on Claim 1, likewise includes this additional element.

As previously mentioned, in order to establish a prima facie case of obviousness, the third criteria is that the prior art reference (or references when combined) must teach or suggest all the claim elements. Neither Outlook 98 nor CallegraDesk disclose inventions wherein no less than two such virtual mailboxes from among the plurality of virtual mailboxes are capable of such

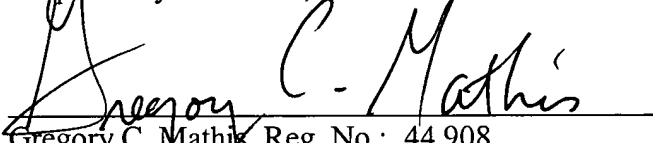
sorting. Therefore neither Outlook 98 nor CallegraDesk, separately or in combination, teach or suggest all the claim elements of the present invention, and Applicants respectfully submit that a finding of obviousness in regard to Claims 1 and 74 is unsupported by these references.

CONCLUSION

Based on the reasons and rationale set forth herein, Applicants respectfully submit that the rejections have been overcome. Accordingly, Applicants request that the claims be allowed to issue. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (512) 499-6200.

Date: October 10, 2002

Respectfully submitted,



Gregory C. Mathis, Reg. No.: 44,908
Customer Number: 020790

ATTORNEY FOR APPLICANTS

Akin, Gump, Strauss, Hauer & Feld, L.L.P.
300 West 6th Street, Ste. 2100
Austin, Texas 78701
Tel: (512) 499-6200
Fax: (512) 499-6290